



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/127,112 07/31/98 MARCUS

B 005

028554 QM22/0618  
VIERRA MAGEN MARCUS HARMON & DENIRO LLP  
685 MARKET STREET, SUITE 540  
SAN FRANCISCO CA 94105

EXAMINER

ROVNAK, J

ART UNIT

PAPER NUMBER

3713

DATE MAILED:

06/18/01

24

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/127,112

Applicant(s)

MARCUS ET AL.

Examiner

John E. Rovnak

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 49-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 49-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 21.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

***Response to Arguments***

1. Applicant's arguments with respect to claims 49-69 have been considered but are moot in view of the new ground(s) of rejection.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 49-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tooley (U.S. 5,252,814, made of record in applicant's IDS filed 4/2/01).
4. Tooley discloses a computer system comprising: a plurality of hand-held objects (38) having a unique visual aspect and a component exhibiting a characteristic representing said visual aspect (36); a surface including at least a section capable of supporting said plurality of hand-held objects; a detecting element proximate to at least said section of said surface (34); a personal computer, including: a storage device for storing executable code (46, 48); a processor for processing at least the executable code (44), and an output device for presenting a user interface (40); a component within said hand-held objects capable of affecting an electrical change in at least a portion of said detecting element (36); said processor being capable of identifying said visual aspect of said hand-held object as a result of said electrical change, and a position of said hand-held object on said surface (col. 3 lines 51-54). Tooley does not identify a first and a second processor. However, it would have been obvious to one of ordinary skill in the art that microprocessor 44 could include sub-processors, one dedicated to the detecting elements for encoding information and the other for processing executable code for recognizing said visual aspect and position. Tooley does not identify a loading

device for loading executable code, but such a loading device would have been conventional in the art for such computer systems and would have been obvious to one of ordinary skill in the art to include with the Tooley system for code updates. While Tooley does not present a substantially horizontal surface for the section capable of supporting said plurality of hand-held objects, it would have been obvious to one of ordinary skill in the art that the Tooley detecting surface (30) need not be inclined for the identification of said visual aspect and position of said hand held objects. The inclined surface of Tooley is for the improvement in speed of the detecting process. It would have been obvious to one of ordinary skill in the art that without the inclination of the surface, the user of the system could hand-guide the hand-held objects over the detecting surface for the same identification process as claimed.

5. Regarding claims 50 and 60, Tooley discloses a grid on his detection system surface which could be a conventional thin wire grid, use of which would have been obvious to one of ordinary skill in the art.

6. Regarding claims 51 and 61, it would have been obvious to one of ordinary skill in the art that the Tooley system, being an electronic system, comprises a plurality of electrically conductive wires in the detecting elements.

7. Regarding claims 53-56 and 62-65 it would have been obvious to one of ordinary skill in the art that the hand held object (38) would comprise an alphanumeric character (product Trademark or other information, and bar-code ID), and/or symbol, and/or picture, and/or color.

Art Unit: 3713

8. Regarding claims 57 and 69, it would have been obvious to one of ordinary skill in the art, in view of figure 2 and the arrangement of the detecting elements, that the Tooley detecting elements detect a position of said hand-held objects using triangulation.
9. Regarding claims 58, 59 and 67-68, it would have been obvious to one of ordinary skill in the art that the above discussed first and second sub-processors of Tooley would comprise a communications link. Furthermore, use of a wireless communication link between processors would have been conventional knowledge in the art and therefore would have been obvious to one of ordinary skill in the art as a possible communication method for use in the Tooley system.
10. Regarding claim 66, it would have been obvious to one of ordinary skill in the computer art that the central processor of Tooley could be that of a personal computer.
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Taylor discloses a board coupled to a computer terminal to record the position of playing pieces.

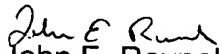
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John E. Rovnak whose telephone number is (703) 308-3087. The examiner can normally be reached on Monday & Tuesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia M Wallace can be reached on (703) 308-4119. The fax phone

Art Unit: 3713

numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

  
John E. Rovnak  
Primary Examiner  
Art Unit 3713

June 13, 2001